

Attorney Docket No. 37837-75702
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Mark Pratt et al.	Conf. No.:	1918
Serial No.:	09/903,001	Art Unit:	3687
Filed:	July 11, 2001	Examiner:	Frenel, Vanel
For:	Audio/Video Automated Payment Facility		

RESPONSE TO OFFICE ACTION

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Barnes & Thornburg Customer No: 2 3 6 4 3 U.S. Patent and Trademark Office

Sir:

In response to the office action mailed 19 March 2008, please consider the following remarks.

The office action mailed 19 March 2008 at page 2 acknowledges applicants' appeal brief filed 20 September 2006 and then states "PROSECUTION IS HEREBY REOPENED as set forth below." A single rejection of all of the claims follows wherein claims 1-13 stand rejected under 35 U.S.C. 103(a) as unpatentable over Admasu et al. (U.S. Publication No. 2002/0032601) in view of Martinez (U.S. Patent No. 5,168,354).

At the outset it is noted that Section 1002.02(d)2 of the Manual of Patent Examining Procedure indicates that reopening of prosecution after the filing of an appeal brief requires the approval of the Supervisory Patent Examiner. The 19 March 2008 office action does not have any indication of consideration or approval of the new ground of rejection by a supervisory patent examiner. Prosecution of the present application includes five office action rejections (mailed 09 September 2004, 18 May 2005, 28 June 2006, 20 June 2007 and 19 March 2008) with applicants having filed two appeal briefs (filed 21 April 2006 and 29 January 2007). Neither of applicants' appeal briefs have been forwarded to the Board for consideration. After each appeal

brief a new ground of rejection was mailed to applicants. Applicants request reconsideration of the present standing rejection for the following reasons. In view of the above noted procedure at Section 1002.02(d)2 and the present new ground of rejection, applicants request that any future rejection be authorized by a supervisory patent examiner. In view of the extended prosecution of this application applicants request a prompt decision on this response to the 19 March 2008 office action.

The rejection of claims 1-13.

The office action rejection states that

Admasu does not explicitly disclose means for providing two-way video and audio communication with a monitoring facility remote from said payment terminal.... Martinez [sic] suggests that the system having means for providing two-way video and audio communication with a monitoring facility remote from said payment terminal (See Martinez, Col.4, lines 60-68 to Col.5, line 31). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Martinez within the system of Admasu with the motivation of providing a remote order station and an inside attendant station which utilizes a communication system capable of providing two, eye-to-eye visual, as well as audio, communication in an efficient and inexpensive manner (See Martinez, Col.3, lines 1-6).

Claim 1 is directed to an automated payment system for a parking facility, comprising an exit gate operable to control egress from the parking facility; and a payment terminal including means for assessing a payment amount, means for receiving the payment amount, means for opening said exit gate upon receipt of the payment amount, and means for providing two-way video and audio communication with a monitoring facility remote from said payment terminal. Applicants' disclosure (see especially Fig. 1) includes an exit facility 10 having a payment terminal 20, a video camera 40, a video display 42 and speakers/microphones 43, 44. Applicants' disclosure (U.S. Publication No. 2003/0014316 at paragraph 24) states that

the payment terminal 20 is remotely connected to a workstation occupied by a human. A video camera transmits an image of the attendant to the payment terminal 20 for display on the monitor 42. Likewise, two-way communication between the attendant and the driver is facilitated by the speakers/microphones 43 and 44. The video camera 40 transmits an image of the person at the payment terminal to provide the live attendant with commensurate human interaction.

Neither Admasu et al. nor Martinez et al. disclose applicants' disclosed structure (or an equivalent) for providing two-way video and audio communication with a monitoring facility remote from said payment terminal. Admasu et al. does not provide a video camera and video display at an exit terminal. In Admasu et al. the driver presents an intelligent card 56 at the exit gate, there is no video camera and display at the exit. Martinez et al. does not provide a video camera and video display at an exit terminal. In Martinez discloses an audio and video display at the entrance, not at an exit. Accordingly, Admasu et al. and Martinez et al. cannot not and do not combine to arrive at the claimed automated payment system for a parking facility comprising an exit gate operable to control egress from the parking facility and... means for providing two-way video and audio communication with a monitoring facility....

The statement of obviousness in the rejection urges that it would have been obvious to have included the Martinez' audio visual order station (for food) in Admasu **with the motivation of providing a remote order station and an inside attendant station**. Admasu et al. relates to a parking lot and it would not have been obvious to provide an order station (for food) as taught by Martinez et al. to the parking lot of Admasu et al. There is nothing in either Admasu et al. or Martinez et al. that would have motivated one of ordinary skill in the art to provide Admasu et al.'s exit with applicants' means for providing two-way video and audio communication as recited in claim 1. The examiner bears the initial burden of presenting a prima facie case of obviousness.¹ The present rejection does not provide proper motivation for the alleged combination of Admasu et al. and Martinez et al. and thus does not provide a prima facie case of obviousness.

Claim 5 includes a limitation similar to that in claim 1 discussed above, i.e., claim 5 requires a means for providing two-way video and audio communication between said central monitoring facility and said payment terminal at each of said plurality of exit facilities. Claim 5 avoids the rejection for at least the same reasoning as noted above with respect to claim 1.

¹ See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

Claim 10 is similar to claim 1 in that claim 10 requires an automated payment system comprising an apparatus for calculating a payment amount, an apparatus for receiving the payment amount, a gate apparatus operable to control access to the facility in response to receipt of the payment amount; and a two-way video and audio communication system linking the automated payment system with a monitoring facility remote from the automated payment facility. As discussed above, Admasu et al. has no two-way audio/video and Martinez et al. has no gate control (e.g., exit) with his two-way audio/video.

For all of the above reasons, independent claims 1, 5 and 10 (and dependent claims 2-4, 6-9 and 11-13) avoid the combination of Admasu et al. and Martinez et al. The allegation in the office action that there is motivation for modification of Admasu et al. appears to stem from an improper hindsight attempt to reconstruct applicants' invention from bits and pieces in the prior art. Such attempt is improper. See, *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). This principle was affirmed by the Court's statement that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 127 S.Ct. at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

The test for obviousness is "whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention."² Applicants' disclosure relates to automated payment at an exit and discusses audio and video at such exit. None of the prior art of record address the problems and solutions offered by applicants' invention. The prior art of record does not teach or suggest the claimed combination of elements including audio and video at the exit. In at least this regard, the prior art of record does not even address the subject matter as a whole of the present invention. For at least this additional reason, there is no prima facie case for the above-noted rejection of the present claims.

In view of the above, it is submitted that all of the remaining claims (Nos. 1-13) are in condition for allowance and such action is respectfully requested.

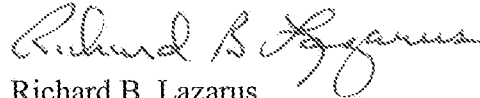
If there is any issue remaining to be resolved, the examiner is invited to telephone the undersigned at (202) 371-6348 so that resolution can be promptly effected.

² *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed.Cir. 1991).

It is requested that, if necessary to effect a timely response, this paper be considered a Petition for an Extension of Time sufficient to effect a timely response with the fee for such extensions and shortages in other fees, being charged, or any overpayment in fees being credited, to the Account of Barnes & Thornburg LLP, Deposit Account No. 10-0435 (37837-75702).

Respectfully submitted,

BARNES & THORNBURG LLP

A handwritten signature in cursive script, appearing to read "Richard B. Lazarus".

Richard B. Lazarus

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